



TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

6

Application Number

10/056,312

Filing Date

January 24, 2002

First Named Inventor

Daryl S. Meredith et al.

Art Unit

3724

Examiner Name

I. Hamilton

Attorney Docket Number

TN-1488

ENCLOSURES (check all that apply)

☒ Fee Transmittal Form☐ Fee Attached☐ Amendment / Reply☐ After Final☐ Affidavits/declaration(s)☐ Extension of Time Request☐ Express Abandonment Request☐ Information Disclosure Statement☐ Certified Copy of Priority Document(s)☐ Reply to Missing Parts/
Incomplete Application☐ Reply to Missing Parts
under 37 CFR 1.52 or 1.53☐ Drawing(s)☐ Licensing-related Papers☐ Petition☐ Petition to Convert to a
Provisional Application☐ Power of Attorney, Revocation
Change of Correspondence Address☐ Terminal Disclaimer☐ Request for Refund☐ CD, Number of CD(s) _____☐ Landscape Table on CD☐ After Allowance Communication to TC☐ Appeal Communication to Board
of Appeals and Interferences☒ Appeal Communication to TC
(Appeal Notice, Brief, Reply Brief)☐ Proprietary Information☐ Status Letter☒ Other Enclosure(s)
(please identify below):

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Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm

Black & Decker Inc.

Signature

Printed Name

Adan Ayala, Esq.

Date

February 9, 2006

Reg.
No.

38,373

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Signature

Typed or printed name

Adan Ayala, Esq.

Date

February 9, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Effective on 12/08/2004.

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

**FEE TRANSMITTAL
for FY 2005**☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$) 500**Complete if Known**

Application Number	10/056,312
Filing Date	January 24, 2002
First Named Inventor	Daryl S. Meredith et al.
Examiner Name	I. Hamilton
Art Unit	3724
Attorney Docket No.	TN-1488

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify) : _____

☒ Deposit Account Deposit Account Number: 02-2548 Deposit Account Name: Black & Decker (U.S.) Inc.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayments of fee(s) ☒ Credit any overpayments

Under 37 CFR 1.16 and 1.17

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee(\$)	Fee(\$)	Small Entity Fee(\$)	Fee(\$)	Small Entity Fee(\$)	
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

2. EXCESS CLAIM FEES**Fee Description**

Each claim over 20 (including Reissues)

Each independent claim over 3 (including Reissues)

Multiple dependent claims

	Small Entity Fee (\$)	Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180
Multiple Dependent Claims	Fee (\$)	Fee Paid (\$)
_____ -20 or HP= _____ x _____ = _____	_____	_____

Total Claims **Extra Claims** **Fee(\$)** **Fee Paid (\$)**

_____ -20 or HP= _____ x _____ = _____

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims **Extra Claims** **Fee(\$)** **Fee Paid (\$)**

_____ - 3 or HP= _____ x _____ = _____

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets **Extra Sheets** **Number of each additional 50 or fraction thereof** **Fee (\$)** **Fee Paid (\$)**

_____ - 100 = _____ / 50 = _____ (round up to a whole number) x _____ = _____

4. OTHER FEE(S)

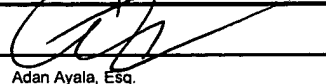
Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Appeal Brief

Fees Paid (\$)

\$500

SUBMITTED BY

Signature		Registration No. (Attorney/Agent)	38,373	Telephone	410-716-2368
Name (Print/Type)	Adan Ayala, Esq.	Date	February 9, 2006		

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Serial No. 10/056,312

UTILITY PATENT

B&D No. TN -1488



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: **Daryl S. Meredith et al.**

Serial No.: **10/056,312**

Examiner: **I. Hamilton**

Filed: **January 24, 2002**

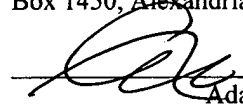
Group Art Unit: **3724**

For: **MITER SAW**

Assistant Commissioner for Patents
Washington, DC 20231

SECOND REPLY BRIEF

I, Adan Ayala, Reg. No. 38,373, certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on 2-9-06


Adan Ayala

Dear Sir:

This is in response to the Examiner's Answer mailed on January 25, 2006.

In the Reply Brief, Applicants/Appellant noted that, since a belt is not used in the Tsune backlash eliminator assembly or necessary for such backlash eliminator assembly to exist in a saw, a person skilled in the art would not have added the Tsune belt to Ushiwata to provide a backlash eliminator assembly. Therefore, the Examiner had not provided a valid rationale for combining Ushiwata and Tsune.

Rather than providing any evidence that a belt is used in or necessary for the Tsune backlash eliminator assembly (or even why such backlash eliminator assembly would be used in a miter

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saw), the Examiner has complained that Applicants/Appellant has “severely twisted the Examiner’s words by changing ‘the backlash eliminator’ to –a backlash eliminator--.” The Examiner alleges that what he meant to say was effectively that “the belt and pulley are required in the configuration of any apparatus that has the backlash eliminator [associated with a belt] because of the spatial arrangements and spatial constraints.”

Such clarification confuses matters further because Tsune’s backlash eliminator assembly 16 does not have a belt. Instead, the Tsune belt is used to transmit motion between drive shaft 10 and pulley 9. Tsune, col. 2, lines 12-14. This motion goes through several stages until it gets to the final stage, where the backlash eliminator assembly is located. Tsune, col. 2, lines 23-24 (“A backlash eliminator 16 is provided on the final stage gear 15”).

Nonetheless, the Examiner’s clarification still does not explain why a person would add a belt to Ushiwata to provide a backlash eliminator in view of the fact that the Tsune backlash eliminator does not have a belt. Applicants/Appellant submit that, since a belt is not used to eliminate backlash, a person skilled in the art would not add a belt to Ushiwata for backlash elimination, as suggested by the Examiner. Therefore, the alleged motivation to combine is invalid.

Because the Examiner has failed to identify a valid motivation to combine Ushiwata and Tsune, no proper *prima facie* case of obviousness can be made. Therefore, Claim 1 is patentable over Ushiwata/Tsune. Accordingly, Applicant/Appellant urges the Board to reverse the Examiner’s improper rejection of the claim under Ushiwata/Tsune and to allow such claim.

The Examiner also mentions that Applicants/Appellant's citation of Tsune '081 supports his positions that all apparatus having the Tsune backlash eliminator would require a belt/pulley system because Tsune '081 is "silent as to which mechanism... is being used to drive the second gear 74." In the Reply Brief, Applicants/Appellant noted that gears could be disposed between the motor and the second gear 74 for driving gear 74 in Tsune '081. The Examiner notes that such arrangement is "speculative." Applicants/Appellant submit that a person skilled in the art would know how to provide gears between a motor and a final stage gear in order to have the final stage gear be driven by the motor. Since such alternative is well known in the art, it would not be speculative to implement such a solution. Thus, the Examiner cannot argue that a backlash eliminator requires a belt/pulley drive system.

Finally, the Examiner argued that Applicants/Appellant's admission that the motor is spaced away from the backlash assembly would necessitate a mechanism, such as the belt/pulley system. As discussed in the Reply Brief, Applicants/Appellant agree that the motor is spaced away and that a power transmission mechanism, such as intervening gears, would be useful. Such need however does not necessitate a belt, as alleged by the Examiner.

Ultimately, the Examiner is missing the point. A person skilled in the art would not combine the Tsune belt with the Ushiwata saw "to provide a backlash eliminator assembly" because miter saws do not use a backlash eliminator assembly. More importantly, the Tsune belt does not provide a backlash elimination function. Thus, Applicants/Appellant submit that, because the Tsune belt does not provide backlash elimination, a person skilled in the art would

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not add the belt to the Ushiwata saw to provide a backlash eliminator assembly, as argued by the Examiner.

Because the Examiner has failed to identify a valid motivation to combine Ushiwata and Tsune, no proper *prima facie* case of obviousness can be made. Therefore, Claim 1 is patentable over Ushiwata/Tsune. Accordingly, Applicants/Appellant urge the Board to reverse the Examiner's improper rejection of Claim 1 and to allow such claim.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Adan', is written over a horizontal line.

Adan Ayala, Reg. No. 38,373
Attorney for Applicants
Phone No. (410) 716-2368